

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-8 and 14-21 are pending in the application. Claims 1-8 are amended by the present amendment. Support for the amended claims can be found at least at Figs. 1 and 7 and their corresponding descriptions in the specification. No new matter is presented.

In the Office Action, Claims 1-8 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; Claims 1-8 are rejected under 35 U.S.C. § 101, as directed to non-statutory subject matter; and Claims 14-21 are indicated as allowed.

The Office Action rejects Claims 1-8 under 35 U.S.C. § 112, first paragraph, asserting that the specification fails to define the term “module” in the specification. Applicants respectfully traverse this rejection noting that some components in Claims 1-8, which are considered to be hardware, are amended to more specifically recite “database” or “device” while some components that are computer programs or “software routines” maintain the language “module”. Applicants further submit that the term “module” is supported by the originally filed disclosure.

With respect to the written description requirement, there is no *in haec verba* requirement, and claim limitations may be supported by the specification through *express, implicit, or inherent* disclosure.<sup>1</sup> To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.<sup>2</sup>

If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly

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<sup>1</sup> MPEP § 2163.

<sup>2</sup> *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991).

described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (*stating "the description need not be in ipsius verbis [i.e., "in the same words"] to be sufficient"*).

Thus, the failure to use the express term "module" in the specification is an insufficient basis for concluding lack of written description, since at least p. 3 of the Office Action concedes that "the term module is most commonly used in the art pertinent to Applicant's Specification to describe a software routine."

The analysis of whether the specification complies with the written description "is conducted from the standpoint of one of skill in the art. Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement."<sup>3</sup>

Moreover, the MPEP discusses several factors that must be considered in order to make a 112, first paragraph, rejection for lack of written description. The MPEP states:

Whether the specification shows that applicant was in possession of the claimed invention is not a single, simple determination, but rather is a factual determination reached by considering a number of factors. Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention.

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The description needed to satisfy the requirements of 35 U.S.C. 112 "varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence." *Capon v. Eshhar*, 418 F.3d at 1357, 76 USPQ2d at 1084.

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***Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first***

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<sup>3</sup> Page A-7 of the USPTO's *Written Description Training Materials*, revision 1, March 25, 2008.

***paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out."***<sup>4</sup>

The outstanding Office Action fails to provide any explicit analysis as to the above-noted factors, which are pertinent to a determination of compliance with the written description requirement. Thus, the outstanding Office Action has failed to set forth a *prima facie* case of failing to comply with the written description requirement.

Further, Fig. 1 and pp. 40-50 of the specification describe that the service verifying system 10 includes, for example, at least first 14 and second 15 communication devices that are configured to communicate with both a service utilizing terminal 40 and an authentication requesting terminal 30 via a wireless LAN and/or a mobile phone link. Thus, these communication devices are clearly hardware interfaces configured to exchange information over various communication links with other devices. Additionally, the various devices (e.g., authenticating device, other service availability determining device, etc.) are considered to be programs or software routines that work cooperatively with the various hardware components (e.g., communication devices 14 and 15, authentication information database 11, available service information database 12, etc.) within the service verifying system 10 to provide services to the service utilizing terminal 40 and/or the authentication requesting terminal 30. Moreover, as noted above, p. 3 of the Office Action concedes that "the term module is most commonly used in the art pertinent to Applicant's Specification to describe a software routine."

Thus, a person of ordinary skill in the art would recognize that the inventor was in possession of the claimed invention at the time of filing and the written description requirement is satisfied. Accordingly, Applicants respectfully request that the rejection of Claims 1-8 under 35 U.S.C. § 112, first paragraph, be withdrawn.

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<sup>4</sup> MPEP §2163, emphasis added.

The Office Action also rejects Claims 1-8 under 35 U.S.C. § 101, as directed to non-statutory subject matter, citing the term “module” as “commonly used in the art to refer to a software routine”. As noted above, however, certain features in Claims 1-8 are amended to omit the term “module” and now either recite that the various components are either a “device” or “database”, which are clearly tangible features as disclosed in the originally filed specification. More particularly, and as noted above, Claims 1-8 are amended describe specific interactions between each of these “modules” and one or more hardware components (e.g., “communication device” and “database”) to provide services to each of a service utilizing terminal 40 and authentication requesting terminal 30.

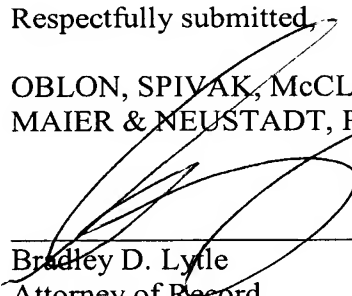
Therefore, Applicants respectfully request that the rejection of Claims 1-8 under 35 U.S.C. § 101 be withdrawn.

Accordingly, Applicants respectfully submit that present application including Claims 1-8 and 14-21 is in condition for formal allowance.

Consequently, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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